

REMARKS

In response to the above-identified Office Action, Claims 1, 3-7 and 9-14 are amended, Claims 2, 8, 15 and 16 are cancelled and no claims are added. Claims 1-16 were examined. Claims 1-16 are rejected. Applicants respectfully request reconsideration of pending Claims 1, 3-7 and 9-14 as amended, in view of at least the following remarks.

I. Claims Rejected Under 35 U.S.C. §102

The Examiner rejects Claims 1-3, 5, 7, 8, 15 and 16 under 35 C.F.R. § 102(b) as being anticipated by Japan Patent No. 05264848 issued to Sumitomo Electric Ind. Ltd. ("Sumitomo"). Applicants respectfully traverse this rejection.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" Lindemann Maschinenfabrik v. American Hoist & Derrick ("Lindemann"), 730 F.2d 452, 1458 (Fed. Cir. 1994)(emphasis added). Additionally, each and every element of the claim must be exactly disclosed in the anticipatory reference. Titanium Metals Corp. of American v. Banner ("Banner Titanium"), 778 F.2d 775, 777 (Fed. Cir. 1985).

Regarding Claim 1, Claim 1 is amended to include the following claim feature, which is neither taught nor suggested by Sumitomo or the references of record

shaping the drop into a mass (30) having a generally frustoconical envelop which is centered on the axis of the fiber (10) and tapered on going away from the adjacent initial coating (20). [Emphasis added.]

Conversely, Sumitomo discloses two solutions in regards to FIGS. 1 and 2 of Sumitomo to obviate the generation of a clearance between optical fiber coatings and a molding resin, as illustrated with reference to FIGS. 3 and 4 of Sumitomo. Applicants respectfully submit that the teachings of Sumitomo, as illustrated with reference to FIGS. 3 and 4, as well as the entire specification of Sumitomo, do not provide any teachings or suggestions with regards to a drop of viscous material shaped into a generally frustoconical envelop, as required by Claim 1.

Furthermore, Claim 1, as amended, includes the following claim feature, which is neither taught nor suggested by either Sumitomo or the references of record:

making a sharp cut in an initial coating of the fiber, in a plane orthogonal to an axis of the fiber (10), the sharp cut covering all radial extension of the coating.

Conversely, Applicants respectfully submit that FIG. 2 of Sumitomo clearly shows a narrow diameterized part and not a sharp cut all over the diameter of the coating, as required by Claim 1. Hence, Applicants submit that neither FIG. 2 nor the corresponding disclosure regarding FIG. 2 of Sumitomo teach or suggest the formation of a sharp cut covering all radial extension of

the coating in the initial coating of the fiber in a plane orthogonal to the access of the fiber, as required by Claim 1.

Accordingly, Applicants respectfully that neither Sumitomo nor the references of record teach or suggest each of the claim features of Claim 1, as described above. Accordingly, Applicants respectfully submit that Applicants' amendment of Claim 1 prohibits the Examiner from establishing a *prima facie* case of anticipation of Claim 1, as amended, under 35 U.S.C. §102(b), since the references of record do not teach each of the features of Claim 1, as amended. Consequently, Applicants respectfully submit that Claim 1 is patentable over Sumitomo, as well as the references of record. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the §102(b) rejection of Claim 1.

Regarding Claims 3, 5, 7 and 8, Applicants respectfully submit that Claims 3, 5 and 7 depend from Claim 1 and therefore include the patentable claim features of Claim 1, as described above. Applicants have cancelled Claim 8. Accordingly, Claims 3, 5 and 7, based on their dependency from Claim 1, are also patentable over Sumitomo, as well as the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §102(b) rejection of Claims 3, 5 and 7.

II. Claims Rejected Under 35 U.S.C. §103

The Examiner rejects Claims 4, 9, 10, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Sumitomo. Applicants respectfully traverse this rejection.

"A *prima facie* case of obviousness is established when the teaching from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q. 2d 1955 (Fed. Cir. 1993) For the reasons provided below, the Examiner cannot establish a *prima facie* case of obviousness in view of the references of record.

As correctly pointed out by the Examiner, Sumitomo fails to teach or suggest the claim features of Claims 4, 9, 10, 12 and 13. Furthermore, Applicants respectfully submit that the aforementioned claims depend from Claim 1, as amended, and therefore include the patentable claim features of Claim 1. As described above with reference to Claim 1, Claim 1 is amended to require the making of a sharp cut covering all radial extension of the coating and the shaping of a drop into a mass having a generally frustoconical envelop. Conversely, Sumitomo does not teach or suggest either the sharp cut or the generally frustoconical envelop by applying a drop of viscous material in shaping the drop, as required by Claim 1. Applicants respectfully submit that FIG. 2 of Sumitomo clearly shows film 4 and does not illustrate, teach or suggest a frustoconical envelop, as required by Claim 1, as amended.

Accordingly, Applicants respectfully submit that Claims 4, 9, 10, 12 and 13, based on their dependency from Claim 1, are patentable over Sumitomo since Sumitomo fails to teach the making of a sharp cut in the initial coating of the fiber and the shaping of a drop into a mass having a generally frustoconical envelop, as required by Claim 1, as amended. Accordingly, Claims 4, 9, 10, 12 and 13, based on their dependency from Claim 1, are also patentable over Sumitomo and the references of record.

Consequently, Applicants respectfully submit that the Examiner cannot establish a *prima facie* case of obviousness of Claims 4, 9, 10, 12 and 13, which depend from Claim 1, since the teachings of Sumitomo, combined with the skill in the art, fail to teach or suggest each of the above claim features of Claim 1, as amended. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 4, 9, 10, 12 and 13.

The Examiner rejects Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Sumitomo in view of Japan Patent No. 60090894 issued to Furukawa Electric Co. Ltd, et al. ("Furukawa"). Applicants respectfully traverse this rejection.

As correctly pointed out by the Examiner, Sumitomo fails to teach or suggest the viscous material applied on each end of the stripe region of the fiber as silicon. Furthermore, as indicated above, Applicants respectfully submit that Sumitomo fails to teach or suggest the shaping of the drop into a mass having a generally frustoconical envelop, as required by Claim 1, as amended. Accordingly, Applicants submit that Claim 1, as amended, is also patentable over Sumitomo in view of Furukawa since Furukawa fails to rectify the deficiencies attributed to Sumitomo in failing to teach or suggest the viscous materials shaped into a mass having a generally frustoconical envelop.

Accordingly, Applicants respectfully submit that Claim 6, based on its dependency from Claim 1, is patentable over Sumitomo in view of Furukawa, as well as the references of record. Consequently, Applicants respectfully submit that the Examiner cannot establish a *prima facie* case of obviousness since the combination of Sumitomo in view of Furukawa, as well as the references of record, fails to teach or suggest each of the claim features of Claim 6. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claim 6.

The Examiner rejects Claims 11 and 14 under 35 U.S.C. §103(a) as being unpatentable over Sumitomo in view of U.S. Patent No. 6,067,393 issued to Wakami, et al. ("Wakami"). Applicants respectfully traverse this rejection.

Regarding Claims 11 and 14, Claims 11 and 14 depend from Claim 1 and therefore include the patentable claim features of Claim 1, as described above. Furthermore, Applicants respectfully submit that the Examiner's citing of Wakami fails to rectify the deficiencies attributed to Sumitomo,

which fails to teach or suggest the making of a sharp cut in the initial coating of the fiber in a plane orthogonal to an access of the fiber where the sharp cut covers all radial extension of the coating, as well as the shaping of a drop into a mass having a generally frustoconical envelop, as required by Claim 1. Applicants respectfully submit that Claims 11 and 14 are also patentable over Sumitomo, Wakami and the references of record based on their dependency from Claim 1.

Consequently, Applicants respectfully submit that the Examiner cannot establish a *prima facie* case of obviousness of Claims 11 and 14 over Sumitomo in view of Wakami since the combination of references fails to teach or suggest each of the claim features of Claims 11 and 14. Consequently, Applicants respectfully submit that Claims 11 and 14, based on their dependency from Claim 1, are also patentable over Sumitomo, Wakami and the references of record. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw the §103(a) rejection of Claims 11 and 14.

CONCLUSION

In view of the foregoing, it is submitted that Claims 1, 3-7 and 9-14 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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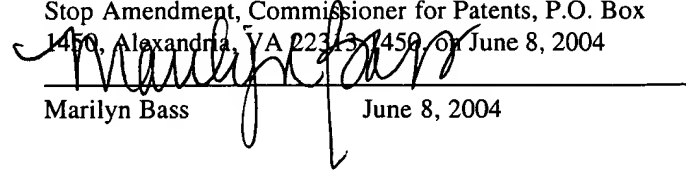
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 8, 2004


Marilyn Bass

June 8, 2004